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EXAMINER KUDDUS, DANIEL A				
ART UNIT 2164		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/583,476

Applicant(s)

MARTIN ET AL.

Examiner

DANIEL KUDDUS

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-20.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 27, 2011 has been entered.

Objection

2. Claims 11, 17, 18 and 19, recited symbol, such as ":" (e.g. claim 11, line 4), "," and "-“ (claim 17, line 4 and 5), which is not a proper format for a claim language. It is recommended to check each of the claim for a proper claim language.

Appropriate correction is required.

Claim Rejections-35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 11, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al. (US 2002/0156921 A1), hereinafter Dutta and further in view of Mikurak (US 7,716,077 B1).

As for claim 11, Dutta teaches **a method of backing up personal data of a wireless communication network subscriber, the personal data being stored within a mobile communication device and backed up in a network server** (see abstract, figure 1), **wherein said method includes an asynchronous backup mode comprising: transmitting a first subset of data from, to a network server for backing up** (see ¶ [0007], backup process may be initiated, for example, by pushing a request to the wireless client via a proxy/gateway server requesting that the client transmit data to be backed up to the backup server), **delaying the backup by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and resuming the backup of, data by transmitting at least one other subset of data from, to the network server at the end of said predetermined period of time** (see ¶ [0031], predetermined intervals or when notified that a user has powered on a wireless device, the data backup server pushes a command to the wireless device instructing the wireless device, such as wireless device..to upload data, such as, for example, calendars, address lists, phone books, notepad data, appointments, or key configuration information, for backup on backup data server. The backup data server stores the information

along with an indication of ownership and then may provide the data to the owner when requested).

Dutta does not explicitly teach the claim recites limitations **dividing a given batch of data to be backed up into a plurality of subsets, the plurality of subsets, said given batch of data, the plurality of subsets of the given batch of data**. Although, Dutta teaches (see abstract, the backed up data may be, for example, phone lists, calendars, address lists, or notes). However, Mikurak teaches such limitations (see page 233, lines 5-12, the rule may be based on gender, age, purchase history or customer demographics. On the other hand, the information that is used to pre-fill forms may be a different set of user profile attributes. For example, this might be name, address, shipping information and payment information..personalization technique may use the same set of user information or may require another subset of user data).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Dutta by applying the teaching of Mikurak for scheduling and planning maintenance and service in a network-based supply chain environment, permit users to create secure virtual networks between their systems, to grant varying levels of access based on user identity may be granted. This could include both access to the virtual network, and to any individual resources shared through the network (see Mikurak, page 169, line 50-59).

Claim 18 have the same subject matter as claim 1 except for the limitation of server for backing up and Dutta such limitation (see [0007] , figure 1). Therefore, claim 18 is rejected for the same reason as applied to claim 1 hereinabove.

Claim 19 have the same subject matter as claim 1 except it is directed to portable wireless communication device and Dutta such limitation (see [0007], figure 1). Therefore, claim 19 is rejected for the same reason as applied to claim 1 hereinabove.

4. Claims 11, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarskog, Johan (WO 01/62029 A1), hereinafter Sarskog and further in view of Van Reenen et al. (WO 03/037015 A1), hereinafter Van Reenen.

As for claim 11, Sarskog teaches **a method of backing up personal data of a wireless communication network subscriber, the personal data being stored within a mobile communication device and backed up within a network server** (see abstract, figure 1), **wherein said method includes an asynchronous backup mode, comprising: transmitting a first subset of data from, to a network server for backing up** (see page 1, line 31 to page 3, line 18, information that has been stored in a so-called SIM card for mobile telephonycontent of telephone book is caused to be transferred to a computer, figure 1), **delaying the backup by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and resuming the backup of, data by transmitting at least one other subset of data from, to the network server at the end of said predetermined period of time** (see page 2, line 1-6, page 2, line 25-30, content of the telephone book to the affiliated memory of a computer at predetermined time intervals for safe storage of said information, via a mobile telephone system. The computer is caused to transfer said information content to a new SIM card replacement in response, via a mobile telephone system).

Sarskog does not explicitly teach the amended claim recites limitations **dividing a given batch of data to be backed up into a plurality of subsets, the plurality of subsets, said given batch of data, the plurality of subsets of the given batch of data.** Although, Sarskog teaches (see page 1, line 11-12, e.g. telephone numbers stored by the user). However, Van Reenen teaches clearly teaches such limitations (see page 2, line 13 to page 4, line 6, data that is backed up may be the names and telephone numbers stored in the telephone device, calendar data, addresses, files, notes, tasks, graphics and the like).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Sarskog by applying the teaching of Van Reenen for controlling connection to the back up facility and the transfer of data to and from the back up storage, thereby data may be backed up automatically (see Van Reenen, page 2, line 11-16).

Claim 18 have the same subject matter as claim 1 except for the limitation of server for backing up and Van teaches such limitation (see figure 1). Therefore, claim 18 is rejected for the same reason as applied to claim 1 hereinabove.

Claim 19 have the same subject matter as claim 1 except it is directed to portable wireless communication device and Van teaches such limitation (see figure 1). Therefore, claim 19 is rejected for the same reason as applied to claim 1 hereinabove.

5. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dormehi et al. (WO 03/007639 A1), hereinafter Dormehi and further in view of Jouenne et al. (US 6,286,085 B1), hereinafter Jouenne.

Dormehi teaches the limitation of **a method of backing up personal data of a wireless communication network subscriber, the personal data being stored within a mobile communication device and backed up within a network server** (see abstract, page 2, line 1-14), wherein said method includes, comprising, **dividing a given batch of data to be backed up into a plurality of subsets, transmitting a first subset of data from the plurality of subsets of the given batch of data to a network server for backing up** (see page 1, line 6-10, page 3, line 3 to page 4, line 18, server being programmed to receive uploaded data from the memory of a mobile telephone; to store same in the associated database record and in the event that the relevant data base record already has existing data stored therein, figure 1, page 2, line 1-14, page 3, line 19-23, already stored....the operation requested by the relevant mobile telephone user), **delaying the backup by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and resuming the backup of said given batch of data by transmitting at least one other subset of data from the plurality of subsets of the given batch of data to the network server at the end of said predetermined period of time** (see page 3, line 18-28, data stored in the relevant data base record under predetermined conditions by way of the internet; for release of the data stored in a data base record to be dependent upon the supply of security information; page 5, line 9 to page 8, line 24, the database record may be subdivided into sub-records if required so that data of a different nature can be separated out, page 2, line 1-4, backup procedure can..generally only be carried out when the mobile telephone and personal computer are physically present....when the user has access to the personal computer).

Dormehi does not explicitly teach the limitation of an asynchronous backup. Jouenne teaches such limitation (see column 1, line 48-50, e.g. asynchronous type backup).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Dormehi by applying the teaching of Jouenne to backing up data and results in a system in which backup is optimized under all situations. Further, data backup would be secure and prevent any data loss between stations (see Jouenne, column 1, line 55-62).

As for claim 12, Dormehi teaches **wherein, in order to resume the backup, the mobile device implements a countdown of the period and sends a resume signal to a chip card in the mobile device at the end of said predetermined period of time** (see page 5, line 9-19).

As for claim 13, Dormehi teaches **wherein, in order to resume the backup, the mobile device implements a countdown of the period and sends a resume signal to a chip card in the mobile device at the end of said predetermined period of time** (see page 5, line 9-19).

As for claim 14, Dormehi teaches **wherein the mobile implements the countdown and sends the resume signal upon receiving an instruction from the chip card** (see page 5, line 9-19).

As for claim 15, Dormehi teaches **wherein the chip card gives said instructions to the mobile device by sending it a Subscriber Identity Module toolkit ("STK") command** (see page 3, line 18-32).

As for claim 16, Dormehi teaches **wherein the chip card gives said instructions to the mobile communication device by sending it a 'GET STATUS' commands** (see page 2, line 7-14).

As for claim 17, Dormehi teaches a **prior assessment step which determines whether the volume of data to be backed up or a corresponding waiting time required to make the mobile device available to the user is determined and compared to a predetermined threshold** (see page 2, line 16-22, page 3, line 10-16), **when the volume of data higher than the predetermined threshold, the backup is performed, when the volume of data is not higher than the predetermined threshold, the backup is carried out according to default mode** (see page 3, line 18 to page 4, line 2).

Dormehi does not explicitly teach according to the asynchronous backup mode. Jounne teaches such limitation (see column 1, line 48-50).

Claim 18 have the same subject matter as claim 1 except for the limitation of server for backing up and Dormehi teaches such limitation (see figure 1). Therefore, claim 18 is rejected for the same reason as applied to claim 1 hereinabove.

Claim 19 have the same subject matter as claim 1 except it is directed to portable wireless communication device and Dormehi teaches such limitation (see figure 1) and is rejected for the same reason as applied to claim 1 hereinabove.

As for claim 20, Dormehi teaches **wherein said device selectively operates, and a normal mode** (see page 6, line 30 to page 7, line 4).

Dormehi does not explicitly teach according to the asynchronous backup mode. Jounne teaches such limitation (see column 1, line 48-50).

Response to Arguments

6. With respect to applicant's arguments on pages 6-11, "*claims 11, 18 and 19.... Sarskog, Van Reenen fails to disclose dividing a batch of data into subsets and then separately*

transmitting each subset from the same batch of data, such that each subset of the same batch of data is transmitted during different transmissions. Neither Sarskog nor Van Reenen, nor any reasonable combination thereof, teaches this claimed feature..claims 18 and

19...same...feature...with respect to claim 11". Examiner respectfully disagrees with applicant's arguments. The amended claims have been rejected under the new ground of rejection. Further, although the claims have been amended. The previously cited references in fact teach amended claim recites limitations. Sarskog in view of Van Reenen teaches the limitation of backing up personal data of a wireless communication network subscriber (see figure 1), wherein said method includes an asynchronous backup mode, comprising: transmitting a first subset of data from, to a network server for backing up (see page 1, line 31 to page 3, line 18, figure 1), delaying the backup by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and resuming the backup of, data by transmitting at least one other subset of data from, to the network server at the end of said predetermined period of time (see page 2, line 1-6, page 2, line 25-30, content of the telephone book (i.e. telephone book has subset of data or first subset of data) to the affiliated memory of a computer at predetermined time intervals (i.e. predetermined period of time) for safe storage of said information, via a mobile telephone system. The computer is caused to transfer said information content to a new SIM card replacement in response, via a mobile telephone system, wherein a new SIM card replacement in response, via a mobile telephone system is referred here as delaying the backup and resuming the backup), Sarskog does not explicitly teach the amended claim recites limitations dividing a given batch of data to be backed up into a plurality of subsets, the plurality of subsets, said given batch of data,

the plurality of subsets of the given batch of data. Although, Sarskog teaches (see page 1, line 11-12, e.g. telephone numbers stored by the user). However, Van Reenen teaches clearly teaches such limitations (see page 2, line 13 to page 4, line 6, data that is backed up may be the names and telephone numbers (i.e. batch of data) stored in the telephone device, calendar data, addresses, files, notes, tasks, graphics (plurality of subsets) and the like). Note that, Sarskog teaches the limitation of predetermined period of time. As such, combine reference teaches claim recites limitation.

7. With respect to applicant's arguments on pages 12-16, "Dormehl and Jouenne...does not in any way pertain to the manner in which information is transmitted from a mobile communication device to a server...silent with respect to first dividing information in the mobile phone into a plurality of subsets, sending a first subset from the plurality of subsets, waiting a predetermined amount of time, and sending another subset from the plurality of subsets of the same batch of data..no way is analogous..in claim 11....nowhere does Dormehl state that..a predetermined amount of time, nor does..is associated with the process of data transmission from phone to the database server for backup...not a legally adequate basis for maintaining the rejection....Examiner has not established that delaying backup of a plurality of subsets from a batch of data by a predetermined period of time..in not sufficient to establish the inherency of that characteristics...Jouenne provides no disclosure that the updated data is divided into subsets...separately transmitted at different times...given batch of data...cannot support..103(a)...also applicable to claim 18 and 19". Examiner respectfully disagrees with applicant's arguments. Dormehl in view of Jouenne in fact teaches amended claim recites limitations. Dormehl teaches a method of backing up personal data of a wireless communication

network subscriber, the personal data being stored within a mobile communication device and backed up within a network server (see abstract, page 2, line 1-14, page 3, line 1-8, server that is accessible by way of the telephone network with which the mobile telephone is associated), wherein said method includes, comprising, dividing a given batch of data to be backed up into a plurality of subsets, transmitting a first subset of data from the plurality of subsets of the given batch of data to a network server for backing up (see page 1, line 6-10, page 3, line 3 to page 4, line 18, server being programmed to receive uploaded data from the memory of a mobile telephone; to store same in the associated database record and in the event that the relevant data base record already has existing data stored therein (i.e. given batch of data) figure 1, page 2, line 1-14, page 3, line 19-23, already stored....the operation requested by the relevant mobile telephone user, wherein replace said existing data with the uploaded data or to compare the uploaded data with the existing data and to update the existing data referred here as dividing a given batch of data to be backed up into a plurality of subsets, page 4, line 4-13, SMS or other suitable message and transmitting same to the mobile telephone with a request that the mobile telephone user respond), delaying the backup by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and resuming the backup of said given batch of data by transmitting at least one other subset of data from the plurality of subsets of the given batch of data to the network server at the end of said predetermined period of time (see page 3, line 18-28, data stored in the relevant data base record under predetermined conditions (i.e. predetermined amount of time) by way of the internet; for release of the data stored in a data base record to be dependent upon the supply of security information; note that, reference teaches data stored in the relevant data base record under

predetermined conditions by way of the internet and data is released 'dependent upon supply of security information', which surely teaches mobile communication device can be free for predetermined period of time, which also teach delaying backup. Further, since relevant data base is releasing under predetermined conditions (i.e. data is not releasing at same time) and based on the supply of security information, therefore the reference clearly teaches predetermined period to time. Furthermore, Dormehl teaches relevant database record release under predetermined condition, such as a PIN number or biometric identification data to the server, therefore, reference clearly teaches mobile device can be free for predetermined period of time, which also teach delaying backup, page 2, line 16-18, page 3, line 3 to page 4, line 18, server that is accessible by way of the telephone network with which the mobile telephone is associated, which reads data transmission from the mobile communication device to server for backup, page 3, line 3 to page 4, line 18, page 5, line 9 to page 8, line 24, the database record may be subdivided into sub-records (i.e. dividing a batch of data into a plurality of subsets) if required so that data of a different nature can be separated out, page 2, line 1-4, backup procedure can..generally only be carried out (i.e. resume) when the mobile telephone and personal computer are physically present....when the user has access to the personal computer). As such, Dormehl teaches claim recites limitations except for the limitation of an asynchronous backup. Jouenne teaches such limitation (see column 1, line 48-50, e.g. asynchronous type backup). Note that, Jouenne also teaches the limitation of the backup is delayed by a predetermined period of time, so as to free the mobile device for a user of the mobile communication device; data is resumed at the end of said predetermined period of time (see abstract, column 3, line 64-67, transmission takes place either when no other call is expected

between the stations, or else at the end of a predetermined time lapse, table 1, column 3, line 31-34, modifying the data in the issuing station is caused to wait, i.e. no further modification can be performed during this time by the program that has modified the data).

Therefore, taken alone or in combination of reference teaches claim recites limitations. Examiner indicates that the references pre-dates the application, therefore qualifying as prior art and come from the same field as the application, therefore qualifying as analogous. Further, since the references teach claim recites limitations, as such a proper prima facie case of obviousness has been established.

All other arguments made by applicant's they all are similar arguments and are moot for the reason set forth above and in the detailed office action.

Determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Examiner, in his office action gave detail explanation of claimed limitation and pointed out exact locations in the cited prior art. Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111[R-1]. Dependent claims rely on independent claims, such as dependent claims 12-17 and 20 depend on claims 11 and 19 and the rejections have been addressed in the detailed office action. The difference in objectives does not defeat the case for obviousness because, as MPEP § 2144 states, the "reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA

1972) ...; *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant' disclosure. Apostolopoulos et al. (US Pub. No. 2003/0009576 A1).

Conclusion

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Daniel A Kuddus whose telephone number is (571) 270-1722. The examiner can normally be reached on Monday to Thursday 8.00 a.m.-5.30 p.m. The examiner can also be reached on alternate Fridays from 8.00 a.m. to 4.30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or processing is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Daniel Kuddus

Date: 08/10/11

/Charles Rones/
Supervisory Patent Examiner, Art Unit 2164